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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,506	01/15/2002	Ingo Klimant	18744-0004	6811

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EXAMINER

KOSLOW, CAROL M

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

cb11

Office Action Summary	Application No. 10/031,506	Applicant(s) KLIMANT, INGO	
	Examiner C. Melissa Koslow	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-57 is/are pending in the application.
- 4a) Of the above claim(s) 53-56 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 46-48, 50, 51 and 57 is/are allowed.
- 6) ☐ Claim(s) 28-32, 38-45 and 49-52 is/are rejected.
- 7) ☐ Claim(s) 33-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

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This action is in response to applicant's amendment of 22 and 26 September 2003. The objection to the abstract is withdrawn due to the amendments to the specification. The objection to the specification is withdrawn due to the applicant's arguments. The 35 USC 112, second paragraph rejections and the 35 USC 112 first paragraph rejection with respect support for poly(meth)acrylic copolymers are withdrawn due to the amendment to the claims. The amendments to the claims have overcome the 35 USC 101 rejections. The translation has perfected applicants filing date and thus the art rejection over Huber et al. The amendments to the claims have overcome the rejections over GB 2,132,348 and WO 99/06821. Applicant's arguments with respect to the dye composition has overcome the art rejection over Zhang et al. Applicant's arguments with respect to the remaining rejections have been fully considered but they are not persuasive.

Newly submitted claims 53-56 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 28-45, based on original claims 1-15, and new claims 53-56 are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used to determine chemical parameters as defined in claim 57.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

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on the merits. Accordingly, claims 53-56 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 39, 40-42 and 50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

There is a discrepancy between the teaching of the specification and the subject matter of claims 39 and 40. Claim 39 teaches the polymer has low absorption of water and/or a minimum gas permeability, while page 7 of the specification teaches the polymer has low absorption of water and a minimum gas permeability. Claim 40 teaches the glass is essentially free of micropores, which allows for the presence of some pores, while page 6 teaches the glass is non-porous.

Claims 40-42 and 52 are not supported by the specification and thus are new matter. Nowhere in the specification is there a teaching or suggestion that the particles can comprise both polyacrylonitrile polymers and a glass. Pages 6 and 7 teach the articles are composed of either a glass or polyacrylonitrile polymers.

Applicants argue the Examiner has not established that one of ordinary skill in the art would doubt Applicant had possession of the claimed invention. The fact the specification only teaches two of the three claimed embodiments means the specification does not reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of all three claimed inventions. Applicants is reminded that the claimed subject

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matter must find antecedent basis in the specification in order for the claims to meet the written description requirement of 35 USC 112, first paragraph. Applicant's arguments with respect to the porosity difference between the claimed glass and the taught glass is not convincing since the specification does not teach the glass has non-porous properties. Page 6, line 35 clearly teaches the particles have a dense nonporous glass matrix. The rejections are maintained.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 28-32, 38, 39, 43-45 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singer et al.

This reference teaches luminescent polymer particles, where the luminescent dye in the particles is shielded from the ambient chemical, biochemical and gaseous parameters. The dyes can be those claimed (col. 12-13) and the particles can be composed of polyacrylonitrile (col. 13, lines 55-66), which is a polymer having low absorption of water and a minimum gas permeability. The particles are produced by diffusing the dye into the preformed particles from a solution or bath dying. Column 16 teaches covalently bonding a biomolecule onto the surface of the particles, which means the particles must be modified to include one of the claimed reactive groups. The reference suggests the claimed particles.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Applicant's arguments are that is no motivation to combine the teaching of the prior art to reach the claimed invention except through impermissible hindsight. The above rejection is not based on a combination of art, but on a single reference which discloses all the claimed elements. Accordingly, applicant's arguments are not convincing and do not overcome the rejection. Line 46 of column 13 teaches the dye can be platinum octaporphyrin, one of the dyes taught in the specification. Thus applicant's argument that the reference does not teach long decay luminescent dyes is not convincing. The rejection is maintained.

Claims 46-48, 50, 51 and 57 are allowable over the cited art of record.

Claims 33-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 46-48, 50 and 51 are allowable for the reasons given for claims 16-18, 20 and 21. The particles of claims 33-37 comprising the claimed dyes and polyacrylonitrile or copolymers, thereof are not taught or suggested by the cited art of record. The process of claims 57 is not taught or suggested by the cited art of record.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (703) 308-3817. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

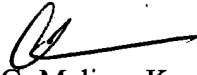
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at (703) 308-3823.

The fax number for all official communications is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661 or (703) 308-0662.

After the move to the new USPTO headquarters in Alexandria Virginia, tentatively scheduled for the week of December 22, 2003, Ms. Koslow's telephone number will be (571) 272-1371 and Mr. Bell's telephone number will be (571) 272- 1362.

cmk
November 3, 2003


C. Melissa Koslow
Primary Examiner
Tech. Center 1700